

Appl. No. 09/753,218
Amdt. Dated 06/30/04
Reply to Office Action of 03/30/2004

REMARKS/ARGUMENTS

This Amendment is in response to the Office Action mailed March 30, 2004. In the Office Action, claims 21 and 23 were objected to based on informalities. Claims 1-3, 7-9 and 13-20 were rejected under 35 U.S.C. §102(e) as being anticipated by Chang (USP 6,487,406). Moreover, claims 5, 6, 11 and 12 were rejected under 35 U.S.C. §103(a) as being unpatentable over Chang while claims 4, 10 and 21-24 were rejected under 35 U.S.C. §103(a) as being unpatentable over Chang in view of Kobayashi (USP 5,724,346). Reconsideration in light of the amendments and remarks made herein is respectfully requested.

Claims 1, 7, 13 and 17 have been amended while claims 5-6, 12 and 21-24 have been cancelled without prejudice. Claims 1-4, 7-11 and 13-20 remain pending in this application.

Claim Objections

The Examiner objects to claims 21 and 23. Based on the cancellation of claims 21-24 without prejudice, Applicants respectfully request withdrawal of the objection.

Rejection Under 35 U.S.C. § 102

Claims 1-3, 7-9 and 13-20 were rejected under 35 U.S.C. §102(e) as being anticipated by Chang (USP 6,487,406). Applicants respectfully disagree.

In order to anticipate a claim under §102(e), Chang must teach every element of the claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Applicants respectfully traverse the rejection because Chang does not teach each and every element set forth in pending independent claims 1, 7, 13 and 17.

For instance, claims 1 and 7 now include the limitations of claims 5-6 and 12, respectively. Moreover, independent claim 13 includes the limitation "An access point...for periodically transmitting a message to one or more wireless units *without any predetermination by the access point that a wireless unit has moved to a different sub-network*. Emphasis added. Chang, however, appears to teach the transmission of Mobile IP registration parameters such as subnet mask, etc. *when a BSC 14 determines that an MS 18 has moved between different subnets*. See Col. 5, lines 53-55 of Chang. Such teachings are contrary to the claimed invention where periodic messages are transmitted to one or more wireless units without any predetermination by the access point that a wireless unit has moved to a different sub-network. Therefore, Chang does not anticipate nor render obvious the invention as set forth in claims 1 and 7 as well as those claims dependent thereon.

With respect to claim 17, Chang does not teach the transmission of a message that comprises information including a network protocol address for a second access point and a subnet mask of a second sub-network. The information is received by a wireless unit can determine if a current network protocol address assigned to a wireless unit is valid for the second

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sub-network. In contrast, Chang teaches transmission of system information that includes only PCS registration area identification and BS identification. See Column 5, lines 41-44 of Chang.

In light of the foregoing, withdrawal of the §102(e) rejection is respectfully requested.

Rejection Under 35 U.S.C. § 103

Claims 5, 6, 11 and 12 were rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Chang. Applicants respectfully submit that a *prima facie* case of obviousness has not been established. Herein, Applicants shall discuss the allowability of independent claims 1 and 7, which now include the limitations of claims 5-6 and 11-12, respectively.

It is alleged that Chang (Col. 5, lines 41-48, 61-64) discloses "the assuming the address to be invalid for a second network." Applicants respectfully disagree. The above-identified section of Chang describes the broadcast and subsequent examination of system information, but offers no teaching or suggestion for determining the validity or invalidity of the current network protocol address based previous storage of the same within the wireless unit. In view of the foregoing deficiencies noted with respect to Chang, Applicants respectfully request the Examiner to reconsider the outstanding rejection based on the cited section of Chang.

Moreover, claims 4, 10 and 21-24 were rejected under 35 U.S.C. §103(a) as being unpatentable over Chang in view of Kobayashi. Besides being allowable on their own merits, claims 4 and 10 are allowable based on their dependency on allowable claims 1 and 7, respectively. Withdrawal of the §103(a) rejection is respectfully requested.

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Conclusion

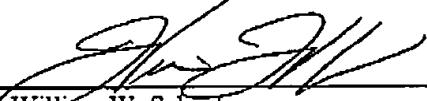
Applicants respectfully request that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Dated: 06/30/2004

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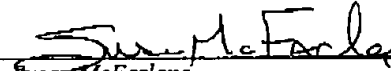
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